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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,596	02/08/2002	Roy Dean Meece	120399	2720

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EXAMINER

CADUGAN, ERICA E

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/071,596	Applicant(s) MEECE ET AL.	
	Examiner Erica E Cadugan	Art Unit 3722	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


 Erica E Cadugan
 Primary Examiner
 Art Unit: 3722

10/071,596

Continuation of 5. does NOT place the application in condition for allowance because: The arguments set forth in the request for reconsideration are not persuasive. Specifically, it is noted that the vast majority of the arguments set forth in the request for reconsideration correspond to the arguments specifically and particularly addressed in the final rejection mailed 1/26/2004. Thus, Applicant is referred to the final rejection for the reasons why those arguments are not persuasive. Applicant does appear to have some clarity issues with Examiner's final rejection, and those will be addressed herein.

Firstly, Applicant still appears to be unclear about what the issue is that is being raised by the Examiner with respect to the "substantially flat-bottomed" hole. Examiner notes that the concept of orbital machining of a hole is not new and is understood. However, as set forth in great detail in the previous office actions, the limitations relating to the "substantially flat-bottomed" hole are not clear since the hole, even by Applicant's definitions, does not remain truly 100% flat-bottomed during the cutting operation. It is thus unclear exactly how much deviation from true flat falls within the limitation "substantially flat-bottomed" since Applicant did not provide any benchmark for such a determination. Applicant has not provided any clarity on this issue. It is noted that Applicant asserts that they "fully explained what is to be considered to be within the language a 'flat-bottomed hole' as quoted above" (page 11). However, it is noted that Applicant's disclosed hole does not appear to be within the dictionary definitions provided by Applicant, since as described in great detail by Examiner in the final rejection, the hole does not remain 100% truly flat during the cutting operation, and thus, the hole does not remain "level, even, or without inequalities of surface". In this particular instance, it is thus unclear what degree constitutes "substantially". Examiner is not asserting that it is never okay or clear to use the term "substantially" in a claim. In fact, in most instances, this term is clear. This particular case, however, has a different and particular set of circumstances from which these rejections arise, which circumstances have already been detailed on the record.

Regarding Applicant's assertions on pages 16-17, it is noted that Applicant appears to be arguing that merely because the base references (Thelin '847, Taquist '647, Eriksson '252, and WO '944) do not explicitly teach each of the claim limitations, that this somehow means that they "teach away" from the present invention. However, this is not persuasive as it is noted that none of the references actually teach against the presently claimed invention, i.e., none of these references actually teach that modifying them in the way described in the final rejection would be a bad thing.

Regarding Applicant's assertions about the German reference, and that Applicant does not know whether the workpiece is a "composite material, or whether holes are being drilled in the workpiece that are larger than the cutting tool", or that "Applicant was not arguing against the DE '365 reference individually" are not persuasive. It is noted that Examiner did not rely on the features being argued with respect to that reference to make the rejection, and thus Applicant *is* in fact arguing the references individually.

Applicant has questioned the meaning of the statement of rejection that sets forth "Claim 20 is rejected under 35 USC 103(a) over any of Thelin '847, Thelin '755, Taquist '674, Eriksson '252, or WO 94/17944, or Eriksson '281 in view of DE '365. Examiner notes that the statement of rejection appears to be clear, and the body of the rejection further serves to make the meaning of this statement of rejection clear (see page 20, for example, which includes the motivation statement for combining the teachings of any of '847, '755, '674, '252, '944, or '281 with the teachings of DE '365). In any event, it is noted that the rejection of claim 20 sets forth a rejection over any one of '847, '755, '674, '252, '944, or 281 in view of the DE '365 reference. Likewise, with respect to claim 21, questioned by Applicant on page 32 of the request for reconsideration, the statement of the rejection as well as the body of the rejection appear to clearly set forth that the claim is being rejected over any one of '847, '755, '674, '252, '944, or '281 in view of the DE '365 reference and further in view of Handbook.